REMARKS

Claims 1-29 are currently pending. Claims 1, 15, and 24 have been amended and claims 5, 11, 21, and 29 have been cancelled. Claim 1 has been amended to incorporate limitations from cancelled claims 5 and 11; claim 15 has been amended to incorporate limitations from cancelled claim 21, and claim 24 has been amended to incorporate limitations from cancelled claim 29. Upon entry of this amendment, claims 1-4, 6-10, 12-20, and 22-28 will be pending.

Applicants note that in the previous Office action dated February 23, 2006, the Office objected to claim 15, and made the following rejections: (1) claims 1-25 under 35 U.S.C. §112, first paragraph, (2) claims 1-25 under 35 U.S.C. §112, second paragraph, (3) claims 1, 8-10, and 12-14 under 35 U.S.C. §102(b), and (4) claims 2-7, 11, and 15-25 under 35 U.S.C. §103(a). Since the Office has not repeated the objection to claim 15 or the rejections under 35 U.S.C. §112, first paragraph, §112, second paragraph, or §102(b), applicants assume these objections and rejections have been withdrawn.

1. Request for Withdrawal of Finality of Action

Applicants respectfully request withdrawal of the finality of the Office action dated August 28, 2006. A final rejection on a second Office action is not proper if it includes a rejection based upon new grounds that are not necessitated by an amendment. According to MPEP §706.07(a):

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)…

As noted above, in the previous Office action dated February 23, 2006, the Office rejected claims 1-25 under 35 U.S.C. §112, first and second paragraphs, claims 1, 8-10, and 12-14 under 35 U.S.C. §102(b), and claims 2-7, 11, and 15-25 under 35 U.S.C. §103(a), but did not reject claims 1, 8-10, or 12-14 under §103(a).

In the response to this Office action, filed May 17, 2006, claim 1 was amended to change the phrase "in flake form" to "flake superabsorbents". As noted in that response, the term "flake superabsorbents" encompasses superabsorbents in flake form. The subject matter of amended claim 1 and dependent claims 8-10 and 12-14 was thus before the Office at the time the February 23, 2006 Office action was issued. The Office has now rejected claim 1 and dependent claims 8-10 and 12-24 under 35 U.S.C. §103(a) as being unpatentable over Everett, et al. The Office has made this rejection final despite the fact that these new rejections were not necessitated by applicant's amendment. Accordingly, the new rejections of the claims were improperly made final.

2. **Rejection of the Claims under 35 U.S.C. §103(a)**

Reconsideration is requested of the rejection of claims 1-4, 6-10, 12-20, and 22-28 under 35 U.S.C. §103(a) as unpatentable over Everett, et al. (U.S. Patent No. 6,437,214).

As amended, claim 1 is directed to an absorbent article for absorbing a complex fluid. The absorbent article comprises an absorbent structure and superabsorbent particles, wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents and have an average surface area to volume ratio of at least about 0.05 μm^{-1}, an average thickness of no more than about 40 micrometers, and a particle size distribution of from about 100 micrometers to about 850 micrometers.

Everett, et al. disclose an absorbent article comprising an absorbent core having multiple absorbent layers that interact in such a way that absorbed liquid is preferentially located in an appointed, high saturation wicking layer. Absorbed liquid is moved quickly through the absorbent layers by means of capillary action. The intake capability of the absorbent system is maintained by keeping a layer of the absorbent system at low saturation levels through as many insults of the product as possible, and controlling intake performance through control of the composite properties of the absorbent layers.

As stated in MPEP §2143, in order for the Office to show a *prima facie* case of obviousness, the Office must meet three criteria: (1) the prior art reference(s) must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings; and (3) there must be some reasonable expectation of success. Applicants assert that the Office has not, and cannot, meet the burden of number (1) and/or (2) above, which requires the Office to show the reference teaches or suggests all of the claim limitations of the instant invention and that there is some suggestion or motivation to modify the reference teachings.

Initially, applicants submit that in contrast to the Office's assertion, Everett, et al. fail to teach or suggest an absorbent article comprising an absorbent structure and superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents. The Office has cited column 7, lines 49-50 and column 15, lines 37-39 of Everett, et al. in support of its assertion that Everett, et al. disclose an absorbent article for absorbing a complex fluid comprising an absorbent structure and superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents.

Applicants respectfully submit that the Office appears to be misinterpreting Everett, et al. Although Everett, et al. do state that the superabsorbent particles used in their absorbent products may have a flake shape, (*see* Everett, et al., col. 15, lines 37-39), there is no disclosure in Everett, et al. of an absorbent article comprising superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents. The passage of Everett, et al. cited by the Office (i.e., col. 7, lines 49-50) merely describes the minimum amount of superabsorbent material in the first layer of the absorbent core.[1] There is no mention in this passage of flake superabsorbents, much less any disclosure or suggestion that at least about 5% (by total weight of the superabsorbent particles) of these superabsorbent particles are flake superabsorbents.

There are also several other passages in Everett, et al. that provide amounts of superabsorbent particles.[2] However, like the above cited passage, none of these passages are referring to the amount of superabsorbent particles that are flake superabsorbents. Rather, they are simply describing the amount of superabsorbent particles that may be present in various absorbent layers of Everett's absorbent product. There is simply no disclosure or suggestion in Everett, et al. of an absorbent product comprising superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents.

In the "Response to Arguments" section of the final Office action, the Office has stated that the disclosure on col. 15, lines 37-39 of Everett, et al. of flake superabsorbents does not distinguish amounts between types of superabsorbents because 100% of the superabsorbents are flake superabsorbents. Applicants respectfully disagree. The cited passage of Everett, et al. merely lists flake shaped superabsorbent particles as one of eight different shapes the superabsorbent particles may have. There is nothing whatsoever in this passage that gives any indication of how many of the superabsorbent particles have a flake shape. Furthermore, there is nothing in this passage that states that all the superabsorbent particles in a particular absorbent articles must be of the same shape, as opposed to some mixture of shapes.

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[1] "Such first layer desirably includes a minimum of not less than about 5 wt% superabsorbent." Everett, et al., col. 7, ln. 49-50.

[2] *See, e.g.*, Everett, et al., col. 23, ln. 35-38 ("The first layer portion can also contain a minimum of not less than about 20% of superabsorbent material by weight, and desirably contains not less than about 30% superabsorbent."); col. 24, ln. 15-18 (stating that the second layer region portion can include a blend of hydrophilic fibers and superabsorbent gelling material, such that about 20-80 wt% of the composite is composed of superabsorbent particles); and col. 26, ln. 21-23 ("The second layer portion can also contain not less than about 5% of superabsorbent material, by weight, and desirably contains not less than about 15% superabsorbent.").

Applicants thus submit that Everett, et al. fail to teach or suggest absorbent articles comprising superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents.

Nor is there any motivation to modify the teachings of Everett, et al. to arrive at an absorbent article comprising superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents. As noted above, Everett, et al. merely list flake shaped superabsorbent particles as one of eight different shapes their superabsorbent particles may have. There is nothing in Everett, et al. to suggest that using flake shaped superabsorbent particles would provide any particular advantage over any of the other shapes listed in Everett, et al. As such, why would one skilled in the art be motivated to produce an absorbent article comprising superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents? One skilled in the art would not be so motivated as there is simply nothing in Everett, et al. to suggest that at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles should be flake shaped.

Furthermore, as noted above, amended claim 1 requires that the flake superabsorbents have an average surface area to volume ratio of at least about 0.05 μm^{-1}, an average thickness of no more than about

40 micrometers, and a particle size distribution of from about 100 micrometers to about 850 micrometers. Significantly, there is no disclosure in Everett, et al. that the flake shaped superabsorbent particles mentioned therein have these properties. Nor would it be obvious to modify the surface area to volume ratio, thickness, and particle size distribution of the superabsorbent particles of Everett, et al. to arrive at applicants' claimed product.

Initially, applicants note that Everett, et al. fail to even teach or suggest what is meant by superabsorbent particles that have a "flake" shape. Rather, Everett, et al. merely list "flakes" as one of several possible superabsorbent particle shapes (see Everett, et al. at col. 15, lines 35-39), but do not specify any properties of flake shaped superabsorbent particles, provide any guidance as to what type of properties would be desirable, or provide any suggestion as to why flake shaped superabsorbent particles should be used over any of the other numerous possible shapes listed in Everett, et al. In the absence of such guidance, why would one skilled in the art be motivated to determine the "optimum" surface area to volume ratio, thickness, and particle size distribution of flake shaped superabsorbent particles, as suggested by the Office? Applicants respectfully submit that one skilled in the art would not even know what properties of flake-shaped superabsorbent particles could or even should be optimized, much less be motivated to optimize the three properties set forth in applicants' claim 1 (i.e., surface area to volume ratio, thickness, and particle size distribution). There would simply be no reason to do so, as there is no suggestion in Everett, et al. that this combination of properties has any particular importance or benefit.

Furthermore, with regard to the Office's statements on modifying Everett, et al.,[3] applicants note that motivation to modify a reference is not found in the holdings of case law. Rather, as noted above and as stated in MPEP §2143, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In the instant case, the Office has not pointed to any passage of Everett, et al. that suggests the flake shaped superabsorbent particles disclosed therein have applicants' claimed surface area to volume ratio, thickness, and particle size distribution, nor provided any reasoning as to why one skilled in the art would be motivated to discover flake superabsorbents having applicants' claimed combination of surface area to volume ratio, thickness, and particle size distribution. It is well settled that the burden is on the Office to provide some suggestion of the desirability to do what the inventor has done; that is, the Office must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of the teachings of the references. Applicants respectfully submit that the Office has not presented any reasons why the teachings of Everett, et al. should be modified, let alone a convincing line of reasoning as required by the MPEP.[4]

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[3] In particular, as noted above, the Office has stated that it would have been obvious to modify the average surface area to volume ratio, thickness, and particle size distribution to achieve the desired results since it has been held that where

Additionally, with regard to the Office's statement that it would be obvious to discover the optimum or workable ranges of surface area to volume ratio, applicants respectfully note that Everett, et al. fail to disclose or suggest any ranges of surface area to volume ratio for flake superabsorbents. As such, why would

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the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only a level of ordinary skill in the art.

[4] MPEP §2142 states:

> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." quoting Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added).

one skilled in the art be motivated to optimize the surface area to volume ratio of the flake shaped superabsorbents in Everett, et al. when Everett, et al. provide no surface area to volume ratio range, nor recognize the advantages of superabsorbent particles having a high surface area to volume ratio? One skilled in the art simply would not be so motivated.

As discussed in the specification of the present invention, the intake speed and capacity of absorbent articles is improved by using flake superabsorbent particles that have a high average surface area to volume ratio. However, there is nothing in Everett, et al. to suggest that using superabsorbent particles having a high surface area to volume ratio would be advantageous. In fact, if anything, Everett, et al. teach away from using superabsorbent particles having a high average surface area to volume ratio in some circumstances. For instance, Everett, et al. state that controlled rate superabsorbent particles may be used in the absorbent articles described therein, and that "controlled-rate superabsorbent can be configured with relatively large particle sizes to provide particles having a low, surface area to volume ratio which thereby produces the desired absorbency rate." *See* Everett, et al., col. 18, ln. 65 to col. 19, ln. 1 (emphasis added). There is thus nothing in Everett, et al. to motivate one skilled in the art to use flake superabsorbents that have an average surface area to volume ratio of at least about 0.05 μm^{-1}.

Claims 2-4, 6-10, and 12-14 depend from claim 1 and are therefore patentable for the same reasons as set forth above for claim 1 as well as for the additional elements they require.

Amended claim 15 is directed to a feminine napkin comprising an absorbent structure and superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents and have an average surface area to volume ratio of at least about 0.05 μm^{-1}, a thickness of no more than about 40 micrometers, and an average particle size distribution of from about 100 micrometers to about 850 micrometers. Claim 15 is patentable for the same reasons as set forth above for claim 1 as well as for the additional elements it requires.

Claims 16-20 and 22-23 depend from claim 15 and are therefore patentable for the same reasons as set forth above for claim 15 as well as for the additional elements they require.

Amended claim 24 is directed to a method for absorbing blood or menses. The method comprises contacting the blood or menses with an absorbent article comprising superabsorbent particles wherein at least about 5% (by total weight of the superabsorbent particles) of the superabsorbent particles are flake superabsorbents and have an average surface area to volume ratio of at least about 0.05 μm^{-1}, a thickness of no more than about 30 micrometers, and a particle size distribution of from about 100 micrometers to about 850 micrometers. Claim 24 is patentable for the same reasons as set forth above for claim 1 as well as for the additional elements it requires.

Claims 25-28 depend from claim 24 and are therefore patentable for the same reasons as set forth above for claim 24 as well as for the additional elements they require.

Claims 2-4, 17-18, and 24-26

Additionally, with regard to claims 2-4, 17-18, and 24-26, the Office has stated that it would have been obvious to one of ordinary skill in the art to modify the average surface area to volume ratio of Everett, et al. to determine the most effective product since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum value of a result effective variable involves only routine skill in the art. As noted above, motivation to modify a reference is not found in the holdings of case law, but rather must be found either in the reference itself or in the knowledge generally available to one of ordinary skill in the art. The Office has not pointed to any passage of Everett, et al. that suggests the flake superabsorbents disclosed therein should have applicants' claimed surface area to volume ratio, nor provided any reasoning as to why one skilled in the art would be motivated to discover flake superabsorbents having applicants' claimed surface area to volume ratio. In this regard, applicants note that the Office's statement that it would have been obvious to modify the average surface area to volume of Everett, et al. to determine the most effective product is not a statement of motivation and is clearly insufficient to meet the Office's burden of a convincing line of reasoning. With all due respect, this reasoning provided by the Office simply begs many questions when analyzed. For example, how and why would modifying the surface area to volume ratio provide for the most effective product? What does "most effective product" even mean? There is simply not enough reasoning supplied by the Office.

Claims 6-7, 15, 19-20, and 27-28

Additionally, with regard to claims 6-7, 15, 19-20, and 27-28, the Office has stated that since Everett, et al. disclose superabsorbent particles substantially as claimed by providing an identical amount of the same superabsorbent (at least 5% in flake form), it can be assumed that the identical product would yield an identical thickness. Applicants submit that this assumption is incorrect.

Initially, applicants note that the Office has in fact stated that the flake shaped superabsorbents of Everett, et al. differ from the flake superabsorbents set forth in applicants claims. In particular, the Office has stated on page 2 of the final action, "The difference between Everett and claim 1 is the provision that the flaked superabsorbents have an average surface area to volume ratio of at least about 0.05 μm^{-1}." Thus, by the Office's own admission, Everett, et al. do not disclose identical flake superabsorbents to those set forth in applicants' claims. Additionally, for the reasons discussed herein, in contrast to the Office's assumption, Everett, et al. do not disclose absorbent structures wherein at least 5% of the superabsorbent particles (by weight of the superabsorbent particles) are flake superabsorbents, and do not disclose flake superabsorbents having applicants' claimed surface area to volume ratio. The Office has pointed to nothing in Everett, et al. that shows that the flake superabsorbents of Everett, et al. are identical to the flake superabsorbents set forth in applicants' claims. Furthermore, even if Everett, et al. did disclose flake superabsorbents in applicants' claimed amounts and having the claimed surface area to volume ratio (which, as discussed above, Everett, et al. do not disclose or suggest), this would still not be a disclosure of the thickness of the flake superabsorbents. The Office has not cited any passage in Everett, et al. that teaches or suggests applicants' claimed thickness, nor has the Office provided any motivation why one skilled in the art would discover applicants' claimed thickness. There is simply no disclosure or recognition in Everett, et al. of the advantages of flake superabsorbents having the claimed properties.

Claims 8-10 and 16

Additionally, with regard to claims 8-10 and 16, the Office has stated that Everett, et al. disclose an absorbent article (or feminine napkin) with the claimed amount of superabsorbent particles, citing col. 26, lines 21-23 of Everett, et al. As noted above, Everett, et al. fail to teach or suggest the amount of superabsorbents that are flake superabsorbents. In particular, the passage cited by the Examiner is merely describing the amount of superabsorbent particles that may be present in the second layer portion of an absorbent article of Everett, et al. ("The second layer portion can also contain not less than about 5% of superabsorbent material, by weight, and desirably contains not less than about 15% superabsorbent."), not the amount of superabsorbents that are flake shaped.

CONCLUSION

In light of the foregoing, applicants request reconsideration of the rejection of claims 1-4, 6-10, 12-20, and 22-28 and allowance of all pending claims. The Commissioner is hereby authorized to charge any government fees which may be required to Deposit Account No. 19-1345.

Respectfully submitted,

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